

Remarks/Arguments

At present, claims 40-64 are pending in the application and all claims stand rejected. New claims 65-73 have been presented. The specification has been objected to for introducing new matter under 35 USC 132(a). Claims 40-64 are also rejected under 35 USC 112, 2nd paragraph, as being indefinite. Claims 40-41, 43-46 and 48 are rejected under 35 U.S.C. §103 as being unpatentable in view of Williams (US Patent No. 4,852,759) in view of O’Neil et al. (4815604) and Morrison (US Pat. App. Pub. No. 2003/0230244). Claims 42, 51, 55, 57, and 62-64 stand rejected as being unpatentable in view of O’Neil et al. and Morrison and Crump (U.S. Patent No. 3,894,650). Claims 49 and 50 are rejected under 35 USC 103(a) as being unpatentable in view of Williams in view of O’Neil and Morrison and further in view of DiNardo (U.S. Pat. No. 3,407,429). Claims 52, 53, and 56 are rejected under 35 USC 103(a) as being unpatentable over Williams in view of O’Neil and Morrison and DiNardo and further in view of Crump.

A. Rejection of Claims 40-64 under 35 USC 112, 2nd paragraph, as being indefinite

Claim 40 has been amended to address the Examiner’s rejection under 35 U.S.C. §112, second paragraph. Specifically, the Applicant has amended the language “flat bottom surface” to read “flat bottom.” In addition, each of the antecedent basis errors noted by the Examiner on page 3 have been rectified.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

B. Objection to the specification for introducing new matter under 35 USC 132(a)

The examiner has objected to the amendment filed April 21, 2009 for introducing new matter. The examiner has identified the “added” material, which is not supported by the original specification as the deletion of the sections “Technical Field, Background, and Summary of the Invention.” The Applicant requests clarification on how deleting these sections of the application can constitute new matter when no matter was added. Support for each of the claims can be found in the remaining disclosure.

C. Rejection of claims 40-41, 43-46 and 48 under 35 U.S.C. §103 as being unpatentable in view of Williams (US Patent No. 4,852,759) in view of O’Neil et al. (4815604) and Morrison (US Pat. App. Pub. No. 2003/0230244)

On page 4 of the Office Action the Examiner contends that Williams discloses a painter’s portable tool tray and topple resistant receptacle as claimed in independent claims 40 and 41, respectively.

The Examiner states that Williams discloses a stackable container except for the double wall of the spill retainer and the guide members. As indicated by the foregoing claim amendments, independent claim 40 has been amended to clarify Applicant’s position in view of the Examiner’s contention that the “spaced-

apart guide members provide a defined area for receiving a handle of a painter's tool and are adapted to insert into a slot between said inner and outer walls of a second stackable painter's tool tray to facilitate stacking of said tool tray."

According to the Examiner, O'Neil teaches both the double wall of the spill retainer and the guide members. First of all, it is unreasonable to assume that one of ordinary skill in the art would combine the flat bottom tray of Williams with the sloped paint roller tray of O'Neil. If a paint can securing member were disposed on the tray of O'Neil the paint would spill out and the tray could not be used for its intended purpose. Further, the examiner has incorrectly asserted that O'Neil teaches a spill retainer wall having spaced inner and outer walls connected along top margins thereof, as recited in claim 40. For this teaching the Examiner cites to reference numbers 28 and 29 of O'Neil. These numerals are actually legs on the tray's brush support section and do not form inner or outer walls of the receptacle. In addition, O'Neil does not disclose spaced apart guide members as recited in claim 40. In contrast, O'Neil discloses roller frame and brush catches 33 and 34 for preventing a roller from slipping down the sloped tray. The catches 33 and 34 are not capable of receiving a handle of a painter's tool as they are positioned at opposite ends of the tray. Further, catches 33 and 34 are not adapted to insert into a slot between said inner and outer walls of a second stackable painter's tool tray to facilitate stacking of said tool tray.

In addition, Morrison does not disclose a painter's tray having inner and outer walls with a slot formed therebetween. Rather, Morrison includes a wall

112 and an outer leg portion 106, which is spaced apart from wall 112 by a significant distance. Certainly the distance between 112 and 106 is not adapted to receive spaced apart guide members for stacking trays. Therefore, it is respectfully submitted that claim 40 is patentable over Williams in view of O'Neil et al. and Morrison and is in condition for allowance.

The applicant also asserts that the claims that depend from claim 40 (i.e. 43 and 48) are also patentable by way of their dependency on claim 40 as well as the additional limitations they recite. Claims 44-46 have been amended such that they now depend from claim 41. In addition, claims 44-46 have been amended to further clarify what the applicant intends to claim. For example, claim 44 has been amended to recite that the "first paint can securing member further includes a raised shoulder disposed on said top side of the flat bottom of said receptacle, said resilient wall being positioned on said raised shoulder." Certainly this limitation is not found in the cited prior art. Each of the claims 43, 45-46 and 48 also contain limitations that further distinguish the claims from the prior art, in addition to being dependent upon a patentable base claim. Thus, the applicant requests that the rejection of dependent claims 43-46 and 48 be withdrawn.

With respect to claim 41, the Applicant asserts that the arguments presented above for claim 40 also apply to claim 41. In particular, it is unreasonable to assume that one of ordinary skill in the art would combine the flat bottom tray of Williams with the sloped paint roller tray of O'Neil. If a paint can securing member were disposed on the tray of O'Neil the paint would spill

out and the tray could not be used for its intended purpose. Further, the examiner has incorrectly asserted that O’Neil teaches a spill retainer wall having spaced inner and outer walls connected along top margins thereof, as recited in claim 41. For this teaching the Examiner cites to reference numbers 28 and 29 of O’Neil. These numerals are actually legs on the tray’s brush support section and do not form inner or outer walls of the receptacle. In addition, O’Neil does not disclose spaced apart guide members as recited in claim 41. In contrast, O’Neil discloses roller frame and brush catches 33 and 34 to prevent a roller from slipping down the sloped tray. The catches 33 and 34 are not capable of receiving a handle of a painter’s tool as they are positioned at opposite ends of the tray. In addition, claim 41 has been amended to recite a “first paint can securing member disposed on the top side of the flat bottom, said paint can securing member including a resilient wall having an interior portion with a protruding member extending therefrom, said paint can securing member being adapted to surround and retain a bottom end of a first diameter paint container to said flat bottom” and a second paint can securing member for securing a second diameter paint container. None of the cited patent documents disclose or suggest a topple resistant receptacle as claimed in claim 41, as amended. Thus, the Applicant respectfully requests that the 103 rejection of this claim be withdrawn.

D. Claims 42, 51, 55, 57, and 62-64 stand rejected as being unpatentable in view of Williams, O’Neil et al. and Morrison and Crump (U.S. Patent No. 3,894,650).

Each of the arguments presented above with respect to Williams, O’Neil et al. and Morrison apply to independent claim 42 as well. The Examiner turns to Crump for the alleged teaching of the slot shield with a brush securing member. For the teaching of the brush retaining member the Examiner points to member 50 having a resilient gripping member 54 arranged to secure a paint brush against a backing surface 52. See OA, page 5, lines 6-7. In fact O’Neil does not disclose a brush securing member having a resilient retaining member at all. O’Neal discloses projecting member 50 having parts 50 and 52 having a space therebetween to facilitate the insertion of a stirring stick. See O’Neil, col. 3, lines 17-24. In addition, in order advance the prosecution, claim 42 has been amended to recite “a brush securing member having a resilient gripping member adapted to secure one of a plurality of different sized paint brushes at a plurality of vertical positions against a backing surface, said resilient gripping member extending into said central opening of said disk.” Certainly, this limitation is not disclosed by Crump. Thus, the Applicant request that the 103 rejection of claim 42 be withdrawn. In addition, the Applicant asserts that claims 51, 55, and 57 are patentable by way of their dependency on claim 42.

With respect to claims 60-64 the Examiner states that in the office action of June 8, 2006 Official Notice was taken that adapter plates and ladder hooks are well known. Applicant understands that this was not traversed and is now

treated as a prior art admission. Claims 60 and 62 recite an adapter plate and a ladder hook, respectively. Clearly there was no official notice taken regarding the limitations of claims 61, 63 and 64, each of which recites numerous additional limitations. The Examiner also states simply that “it would have been obvious to add the adapter plate to provide a means to convert the circular attachment to a rectangular attachment” and “it would have been obvious to add the ladder hook to suspend the receptacle to a ladder.” These statements are insufficient to establish a *prima fascia* case of obviousness. The Examiner has failed to address many of the claim limitations of claims 61, 63, and 64. For example, claim 64 recites a ladder hook formed from a single wire rod, folded over at about its center to form two closely spaced generally parallel rods connected at a first end and shaped to form a generally “U” shape suitable to loop over a ladder rung, wherein the rods are thereafter separated to form spaced opposite ends, arranged to securely engage opposite sides of said receptacle. Thus, the Examiner has not set forth a *prima fascia* case of obviousness with respect to claims 61, 63 and 64.

E. Rejection of claim 47 under 35 USC 103(a) as being unpatentable over Williams, O’Neil et al., Morrison and Demitry

Claim 47 recites that the “receptacle is oblong, having a rectilinear shape at one end and a curved shape at the opposite end.” For this teaching the Examiner looks to Demitry, which the Examiner alleges teaches an oblong tray having a rectilinear end and a curved end. In fact, Demitry discloses a circular

paint board with a rectangular brush rest extending from a peripheral edge of the circular board. See Demitry, column 6, lines 29-39. The oblong receptacle having a rectilinear shape at one end and a curved shape at the opposite end, as recited in claim 47 is clearly different than the paint board of Demitry. Thus, the Applicant asserts that the rejection of claim 47 should be withdrawn.

F. Claims 49 and 50 are rejected under 35 USC 103(a) as being unpatentable in view of Williams in view of O'Neil and Morrison and further in view of DiNardo (U.S. Pat. No. 3,407,429).

As indicated in the foregoing claim amendments, claims 49 and 50 have been amended to further define the claims and to expedite the allowance of the claims. Claim 49 has been amended to recite that the “paint can securing member is disposed on the top side of the flat bottom, said paint can securing member including a resilient wall having an interior portion and an exterior portion, and being adapted to surround and retain a bottom end of a paint container having a first size diameter to said flat bottom.” In addition, Claim 50 has been amended to recite a “second paint can securing member disposed on the top side of the flat bottom, said second paint can securing member including a resilient wall having an interior portion and an exterior portion, and being adapted to surround and retain a bottom end of a paint container having a second size diameter to said flat bottom.” Clearly claims 49 and 50, as amended, are patentable over Williams in view of O'Neil and Morrison and further in view of DiNardo.

G. Rejection of claims 52, 53, and 56 under 35 USC 103(a) as being unpatentable over Williams in view of O’Neil and Morrison and DiNardo and further in view of Crump.

Initially, the Applicant points out that the Examiner does not even address claims 52 and 53 on pages 6-7 under the heading that indicates they are rejected. Rather the Examiner appears to focus on claim 56. However, the again the Examiner fails to point to the teachings of the claimed elements in the prior art. Claim 56 recites that a “first raised shoulder of said disk is arranged to engage an inside surface of a generally circular opening to a paint can.” The Examiner does not address the raised shoulder and instead appears to repeat the argument that was presented for the base claim, 42, from which claim 56 depends. Thus, the Applicant asserts that a prima fascia case of obviousness has not been presented for claim 52, 53 and 56 since all claim limitations have not been addressed.

H. Conclusion

In view of these amendments and remarks, Applicant respectfully requests that all prior rejections be reversed, and all remaining claims pass to allowance and eventual issuance. With respect to the dependent claims that have not been addressed individually, the Applicant asserts that they are patentably as they are based upon patentably independent claims. Should the Examiner should have any additional questions or concerns regarding this matter, he is cordially invited to contact the undersigned at the number provided below.

Date: November 16, 2009

Respectfully submitted,

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